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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/810,506 | 03/19/2001 | Teruaki Taji | 204936US0 | 8250 |

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OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

[REDACTED] EXAMINER

COLLINS, CYNTHIA E

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1638

DATE MAILED: 04/09/2002

14

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/810,506 | TAJI ET AL. |
| | Examiner | Art Unit |
| | Cynthia Collins | 1638 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 19 March 2001.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1, 2 and 4-5, drawn to a method for increasing stress resistance to a plant which comprises introducing into a plant a glactinol synthetase gene encoding a protein of SEQ ID NO:1, classified in class 800, subclass 289, for example.
- II. Claims 1 and 3-5, drawn to drawn to a method for increasing stress resistance to a plant which comprises introducing into a plant a glactinol synthetase gene encoding a protein of SEQ ID NO:2, classified in class 800, subclass 284, for example.
- III. Claim 6, drawn to a method for increasing stress resistance to a plant which comprises increasing glactinol content in the plant body, classified in class 435, subclass 410, for example.
- IV. Claim 7, drawn to a method for increasing stress resistance to a plant which comprises improving glactinol synthetic activity in the plant body, classified in class 435, subclass 468, for example.
- V. Claim 8, drawn to a method for increasing stress resistance to a plant which comprises excessively expressing in the plant body a protein of SEQ ID NO:1, classified in class 800, subclass 289, for example.
- VI. Claim 9, drawn to a method for increasing stress resistance to a plant which comprises excessively expressing in the plant body a protein of SEQ ID NO:2, classified in class 800, subclass 284, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation or different effects.

Inventions I and II require the use of structurally different glactinol synthetase genes. Where structural identity is required, such as for expression, the different gene sequences have different effects. Inventions III-VI have different modes of operation from Inventions I and II and from each other. Increasing the glactinol content in the plant body can be accomplished by methods that do not require the use of a glactinol synthetase gene, such as by the application of glactinol to the plant body. Improving glactinol synthetic activity in the plant body can be accomplished by methods that do not require the use of a glactinol synthetase gene, such as by altering the expression of genes that encode enzymes that function downstream or upstream of glactinol synthetase in the glactinol biosynthetic pathway. Excessively expressing in the plant body a protein of SEQ ID NO:1 or SEQ ID NO:2 can be accomplished by methods that do not require the use of a glactinol synthetase gene, such as by altering the expression of genes that encode transcription factors that increase the expression of an endogenous gene encoding a protein of SEQ ID NO:1 or SEQ ID NO:2. Additionally, where structural identity is required, such as for expression, the different gene products have different effects.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Remarks

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (703) 605-1210. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (703) 306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

CC
March 26, 2002


PHUONG T. BUI
PRIMARY EXAMINER